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EXAMINER	
FABER, DAVID	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,363

Applicant(s)

SAVEKAR, SANTOSH

Examiner

David Faber

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 8, 10 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 8, 10 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Request for Continued Examination filed on 17 September 2007.
2. Claim 7, 8, and 10-11 are pending. Claim 7 is an independent claim.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al (US Patent 5,600,775; 2/4/1997) in further view of Wallace et al (USPGPub 2002/0208112; filed 2/2/2001).

As per independent Claim 7, King et al discloses a decoder for annotating a frame, said decoder comprising:

- memory for storing a data structure, the data structure comprising a compressed representation of a first frame and at least one parameter; (FIG 1, block 14)
- creating a graphic, said graphic display the at least one parameter (Column 2, lines 49-51: King et al discloses created annotations that include free-hand bitmap drawings (graphics). In addition, Applicant discloses the graphic

displays at least one parameter. In Paragraph 0035 of the specification , Applicant disclose a parameter may consist of decode time or presentation time. Thus, the graphic displays time information. King et al discloses that such video frames are indexed by frame number and uses the example, QuickTime, having its index as a video time parameter. (Col 6, lines 35-42; FIG 2, 3)

- frame buffer for storing a second frame, the second frame comprising the first frame and the graphic. (Column 6, lines 51- Column 7, line 11; FIG 1, block 12).

However, King fails to specifically disclose a decompression engine for decompressing the compressed representation of the first frame. However, Wallace et al discloses a process of generating annotations wherein data frames that are compressed are then subsequently decompressed based on MPEG standard in paragraph 0026. Furthermore, Wallace discloses creating annotation (graphic) such as a label that includes text (parameter) wherein images are labeled with annotations. (Paragraph 0023, 0027, 0032) In addition, since Wallace disclose the functionality for decompressing the compressed frame and also creating an annotation, Wallace providing the means and the functionality of a decompressing engine. Therefore, Wallace provides a form of a decompression engine.

It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to modify King et al's annotation method by including therein data compression and decompression means with full motion digital video frames. One of

the ordinary skill in the art at the time of the Applicant's invention would have known that full motion digital video frames can be compressed for optimizing cost and use of less hardware; therefore, would have used Wallace et al's process prior to using King et al's annotation method.

As per dependent claim 8, King et al further discloses a display controller (FIG 1, block 12) that "drives a monitor displaying a graphic user interface" (Column 4, lines 5-9) which inherently contains the scaling capability of a frame based on the rejection of claim 2.

As per dependent Claim 10, King et al fails to disclose that the graphic is selected from a group consisting of a header, a footer, and a margin. However, Wallace et al discloses, e.g. Figure 3 and 4 and paragraph 0037, that the frame includes a header, and a footer.

It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to use King et al's annotation method of with Wallace et al's sample frame, within a data structure, that includes a header, which uniquely identifies the frame (paragraph 0037) since it would have allowed a user to identify the position of a header and its purpose for annotating display time or text without stealing focus of the main intention of the frame.

As per dependent Claim 11, King et al further discloses "an annotation manager includes resources to select in response to user input an indexed data structure to be annotated and resources to create, in response to user input, an annotation data structure." (Column 2, lines 64-67) King et al's statement is equivalent that a number of

parameters are present and receives an indication to user input or selecting a parameter. King et al further discloses a processor is included in Figure 1, block 10, which performs the indication.

Response to Arguments

5. Applicant's arguments filed 17 September 2007 have been fully considered but they are not persuasive.

6. On pages 2-3, in regards to claim 7, Applicant argues that that King and Wallace fail to specifically teach the limitation "a decompression engine for decompressing the compressed representation of the first frame and creating a graphic, said graphic displaying the at least one parameter; and" wherein Applicant argues that it would not be obvious from the combination of King and Wallace since the rationale to combined is not found in the prior art. Applicant supports that statement by stating on page 2 of the Arguments, "Assignee respectfully submits that "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP 2142." Therefore, Applicant uses this reasoning that it would not be obvious to combined King and Wallace. However, the Examiner disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In addition, MPEP 2144 clearly states "*The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law.*" In this case, King et al discloses annotating full motion video and other indexed data structures while Wallace discloses analyzing and annotating an audio-visual sequence that involves decompressing. Thus, King and Wallace discloses a similar field of endeavor. Thus, as discloses in the previous Office action, King fails to specifically disclose a decompression engine for decompressing the compressed representation of the first frame. However, Wallace et al discloses a process of generating annotations wherein data frames that are compressed are then subsequently decompressed based on MPEG standard in paragraph 0026. Furthermore, Wallace discloses creating annotation (graphic) such as a label that includes text (parameter) wherein images are labeled with annotations. (Paragraph 0023, 0027, 0032) In addition, since Wallace disclose the functionality for decompressing the compressed frame and also creating a annotation, Wallace providing the means and the functionality of a decompressing engine. Therefore, Wallace provides a form of a decompression engine.

It would have been obvious to one of the ordinary skill in the art at the time of the Applicant's invention to modify King et al's annotation method by including therein data compression and decompression means with full motion digital video frames. One of the ordinary skill in the art at the time of the Applicant's invention would have known that full motion digital video frames can be compressed and/or decompressed for optimizing cost and use of less hardware; therefore, would have used Wallace et al's process prior to using King et al's annotation method.

7. Furthermore, on page 3, Applicant argues that including data compression and decompression means with fully motion digital video frames results in additional hardware. However, the Examiner disagrees.

The Applicant failed to provide proof that compression and decompression would result in and require more hardware. Wallace does not disclose that compression and/or decompression means require more hardware when describing its functionality to decompress. In addition, it was well-known to one of ordinary skill in the art that data compression and decompression means is made of purely software code, known as algorithms, that can be performed by only software alone, i.e. a software "engine", in which Wallace discloses a form of by performing the functionality to decompress and creating annotations, which would not require any additional hardware.

Conclusion

8. All claims are drawn to the same invention claimed in the parent application prior to the filing of this Continued Prosecution Application under 37 CFR 1.53(d) and could

have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Faber whose telephone number is 571-272-2751. The examiner can normally be reached on M-F from 8am to 430pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

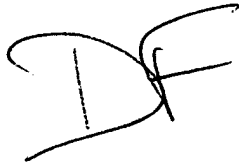

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Status information for unpublished applications is available through Private PAIR only.

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David Faber
Patent Examiner
AU 2178

A stylized handwritten signature consisting of a large 'D' and 'F' joined together.A handwritten signature in cursive script that reads 'Cesar Paula'.

CESAR PAULA
PRIMARY EXAMINER